

REMARKS / DISCUSSION OF ISSUES

Claims 1 – 35 are pending in the application. Claims 1, 24 and 33 are independent.

In the present response, claims 1, 11 – 15, 24, 27 – 31 and 33 are amended. The support for the claim amendments may be found in Applicant's specification, for example, Fig. 9 and page 20 line 29 – page 21 line 20. No new matter is added.

35 U.S.C. 103

Under 35 U.S.C. 103(a) the Office Action rejects claims 1, 2, 4, 9 – 15, 20 – 22 and 24 – 31 over Katabami (US 5,528,002) in view of Kable (US 4,695,680).

Applicant submits that for at least the following reasons, claims 1, 2, 4, 9 – 15, 20 – 22 and 24 – 31 are patentable over Katabami and Kable, either singly or in combination.

For example, claim 1, in part, requires:

“a coil for coupling to ground along substantially the length of the user-holdable device.”

In addition, independent claim 24, in part, also requires:

“a coil for coupling to ground along substantially the length of the user-holdable device.”

In the Office Action, page 3, the Office conceded that Katabami does not expressly disclose that the means for coupling to ground along substantially the length of the user-holdable device. Because of this lack of teaching or suggestion in Katabami, the Office cited Kable. However, Applicant submits that Kable does not cure the defect present in Katabami.

Kable discloses a wall 12, which is an outwardly disposed and electrically conductive wall of the stylus 10 (Fig. 1, column 4, lines 11 – 14 and column 5, lines 32 – 39). However, the wall 12 in Kable is clearly not a coil. Applicant submits that the wall 12 in Kable provides a structure forming the body of stylus 10 (column 5, lines 39 – 45), thus a coil cannot suitably be used as the wall. Therefore, Kable fails

to disclose the claimed feature: a coil for coupling to ground along substantially the length of the user-holdable device.

In view of at least the foregoing, Applicant submits that claims 1 and 24 are patentable over Katabami and Kable, either singly or in combination.

Claims 2, 4, 9 – 15, 20 – 22 and 25 – 31 respectively depend from claims 1 and 24 and inherit all the respective features of claims 1 and 14. Thus, claims 2, 4, 9 – 15, 20 – 22 and 25 – 31 are patentable for at least the reason that they respectively depend from claims 1 and 24, with each claim containing further distinguishing features.

Under 35 U.S.C. 103(a) the Office Action rejects claims 33 – 35 over Katabami in view of Stein et al. (US 5,365,461), hereinafter Stein.

Independent claim 33, in part, requires:

“providing coupling to ground by a coil extending substantially along the length of the user-held device.”

Applicant essentially repeats the above arguments for claims 1 and 24 and applies them to claim 33, pointing out why Katabami fails to disclose the claimed feature: providing coupling to ground by a coil extending substantially along the length of the user-held device. Furthermore, Applicant submits that Stein does not in any way cure the defects present in Katabami as discussed above. Therefore, claim 33 is patentable over Katabami and Stein, either singly or in combination. Claims 34 and 35 are patentable for at least the reason that they depend from claim 33, with each claim containing further distinguishing features.

Under 35 U.S.C. 103(a) the Office Action rejects claims 5 and 6 over Katabami in view of Kable, and further in view of Yamanami et al. (US 4,902,858); claims 7, 8, 19 and 32 over Katabami in view of Kable, and further in view of Ely et al. (US 6,667,740); claims 3, 16 and 17 over Katabami in view of Kable, and further in view of Stein; claims 16 and 18 over Katabami in view of Kable, and further in view of Teterwak (US 5,777,898); and claims 23 over Katabami in view of Kable, and further in view of Colgan et al. (US 6,204,897).

Applicant submits that none of the cited secondary references can cure the defects present in Katabami and Kable as discussed above. Claims 3, 5 – 8, 16 – 19, 23 and 32 respectively depend from claims 1 and 24 and inherit all the respective features of claims 1 and 24. Thus, claims 3, 5 – 8, 16 – 19, 23 and 32 are patentable for at least the reason that they respectively depend from claims 1 and 24, with each claim containing further distinguishing features.

Withdrawal of the rejection of claims 1 – 35 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

By: /Hay Yeung Cheung/
Hay Yeung Cheung
Registration No.: 56,666
Myers Wolin, LLC
(973) 401-7157

Please direct all correspondence to:
Larry Liberchuk
Corporate Counsel
U.S. PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001